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OFFICE OF PETITIONS

In re Application of :
Kaufman et al. :
Application No. 08/980,038 :
Filed: November 26, 1997 :
Attorney Docket No. 2115001184US :

DECISION GRANTING
PETITION

~~In re Application of :
Kaufman et al. :
Application No. 09/819,098 :
Filed: April 11, 2001 :
Attorney Docket No. UMV-1184CPCPA2 :~~

This is a decision on the petition under 37 CFR § 1.53(e) filed May 11, 2001, requesting that an improper Continued Prosecution Application (CPA) under 37 CFR § 1.53(d) be treated as an application under 37 CFR § 1.53(b) and be accorded a filing date of April 11, 2001.

On October 11, 2000, a final Office action was mailed in application No. 08/980,038, which set a three (3) month shortened statutory period for reply. In response, a petition for a three (3) month extension of time and a request for a CPA under 37 CFR § 1.53(d) based on prior application No. 08/980,038 were deposited on April 11, 2001. However, CPA practice no longer applies to applications, other than design applications, if the prior application was filed on or after May 29, 2000.¹ Accordingly, the CPA request was improper because the prior application was filed on or after May 29, 2000.

¹ An earlier CPA was filed in application No. 08/980,038 on July 20, 2000. Thus, 37 CFR 1.53(d)(1)(i) does not permit the filing of a further CPA.

In the event that an applicant files a request for a CPA of a utility or plant application that was filed on or after May 29, 2000 (to which CPA practice no longer applies), the Office will automatically treat the improper CPA as a request for continued examination of the prior application (identified in the request for CPA) under new 37 CFR § 1.114.

The Office treated the CPA request as a request for continued examination (RCE). However, because the RCE was not accompanied by a submission it did not meet the requirements of 37 CFR § 1.114. Therefore, because applicants did not provide a reply to the final Office action with the RCE, the application became abandoned on April 12, 2001.

On May 11, 2001, applicants filed the present petition under 37 CFR § 1.53(e). Applicants stated that after receiving the final Office action of October 11, 2000, applicants intended to file a continuation application of prior application No. 08/980,038, but inadvertently filed a CPA. Applicants requested that the improper CPA be converted to an application under 37 CFR § 1.53(b). Applicants submitted, inter alia, a complete copy of the prior application papers as originally filed, copies of amendments, two declarations and a power of attorney previously filed in application No. 08/980,038, and a supplemental information disclosure statement (IDS).

The petition is granted.

The application under 37 CFR 1.53(b) filed on April 11, 2001, has been assigned application No. 09/819,098. The CPA request, the present petition, the copy of the application papers as originally filed, copies of amendments, two declarations and a power of attorney, and the supplemental IDS have been removed from the file of application No. 08/980,038 and have been placed in application No. 09/819,098. A copy of the CPA request and the present petition will be retained in application No. 08/980,038 to complete the record therein. All further correspondence concerning the application under 37 CFR 1.53(b) should be directed to application No. 09/819,098, not application No. 08/980,038.

The Office finance records will be corrected to show that the \$355.00 filing fee, excess claim fees totaling \$404.00, the \$180.00 fee for submission of an IDS, and the \$130.00 petition fee were paid in application No. 09/819,098, not in application No. 08/980,038.

Application No. 08/980,038 will be returned to Technology Center 1600 for further processing as an application abandoned for failure to respond to the final Office action mailed October 11, 2000.

Application No. 09/819,098 will be forwarded to the Office of Initial Patent Examination for further processing as an application filed under 37 CFR 1.53(b), not under 37 CFR 1.53(d), with a filing date of April 11, 2001, using the copy of the original application papers submitted on May 11, 2001.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Christina T. Tartera at (703) 306-5589.



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